

Application No. 09/911,047
Amendment Dated August 25, 2004
Reply to Office Action of April 9, 2004

REMARKS/ARGUMENTS

By this Amendment, claims 5 and 10-11 are canceled, and claims 1, 12-13, 24, 25 and 27 are amended. Claims 1-4, 6-9, 12-29 are pending.

Favorable reconsideration is respectfully requested in view of the foregoing amendments and the following remarks.

Support for the amendments is apparent in the original specification.

Claims 1-29 stand rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. This rejection is respectfully traversed.

Any inconsistency in defining electric current as a type of electromagnetic radiation is obviated by the foregoing amendments, which delete the term "electromagnetic radiation" from the claims.

In addition, claims 24 and 25 are amended to specify that the stimuli (rather than the signals) are applied.

Accordingly, reconsideration and withdrawal of the indefiniteness rejection are respectfully requested.

Claims 1-6, 8, 11, 17-18, 20, 22, 24-25 and 27 stand rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Kukreti et al. This rejection is respectfully traversed.

Kukreti et al. fails to identically disclose each and every limitation of the claimed invention. Each of the base claims requires the first stimulus and the second stimulus to be photonic or electronic, provided that at least one of the first stimulus and the second stimulus is

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photonic, and that when both are photonic, an intermediate electronic stimulus is applied. Thus, all of the claims require at least one electronic stimulus (first, second and/or intermediate).

The Office Action asserts that the reference's disclosure of adjusting the temperature of the test sample using an electrically heated water bath (the "Haake P2 water bath" and the "Haake PG 20 thermoprogrammer" discussed in the paragraph bridging the left and right columns of page 4265 of Kukreti et al.) constitutes an intermediate "electronic stimulus" as presently claimed.

Although it is the PTO's policy to afford claim terms their "broadest reasonable interpretation" (MPEP § 2111), such an interpretation "must also be consistent with the interpretation that those skilled in the art would reach." *Id.*, citing *In re Cortright*, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999). A person of ordinary skill in the art would not interpret "applying an electronic stimulus to a test sample" to encompass electrical heating of a water bath in which a container containing the test sample is immersed. The electronic stimulus is applied to the water bath, not to the test sample. The water bath, in turn, applies a thermal stimulus to the container, which conducts heat to the test sample. Interpreting the "electronic stimulus" limitation as proposed in the Office Action is clearly unreasonable and inconsistent with the plain meaning of the limitation in light of the present disclosure.

Thus, the Office Action fails to show that Kukreti et al. teaches applying an electronic stimulus to a test sample. Absent such a showing, there is no *prima facie* case of anticipation.

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Accordingly, reconsideration and withdrawal of the anticipation rejection over Kuketi et al. are respectfully requested.

Claims 1, 6, 10-11, 13-14, 17, 20 and 26-27 stand rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent No. 6,391,624 to Megerle et al. This rejection is respectfully traversed.

Megerle et al. was filed June 2, 2000, and claims the benefit of two provisional patent applications: one filed September 16, 1999 and another filed June 3, 1999. Thus, Megerle et al. has an earliest effective filing date (i.e., Section 102(e) date) of June 3, 1999.

Applicants attach a Rule 131 Declaration swearing behind the Section 102(e) date of Megerle et al. 37 CFR 1.131(b) provides that prior invention can be shown with evidence of a reduction to practice of the invention prior to the effective date of the reference. See also MPEP § 715.07 II. "A process is reduced to practice when it is successfully performed." See MPEP § 2138.05 citing *Corona v. Dovan*, 273 U.S. 692 (1928). More generally stated, establishing an actual reduction to practice of an invention requires a showing that "the invention would work for its intended purpose." See, e.g., *Cooper v. Goldfarb*, 154 F.3d 1321, 1327, 47 USPQ2d 1896 (Fed. Cir. 1998).

The Declaration provides evidence that prior to June 3, 1999 the inventors reduced to practice embodiments of the claimed invention. The experiments shown in Exhibit A of the Declaration were sufficient to prove that the claimed process can be successfully performed. The experiments were performed in a NAFTA country (Canada) prior to June 3, 1999 and

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subsequent to December 8, 1993 (the effective date of Section 331 of the North American Free Trade Agreement Act).

Accordingly, reconsideration and withdrawal of the rejection of the anticipation rejection over Megerle et al. are respectfully requested.

Claims 1, 6, 11-17, 21-22, 24-25 and 27-29 stand rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent Application Publication No. 2002/0094531 (Zenhausern). This rejection is respectfully traversed.

Zenhausern was filed September 24, 2000 as a divisional application of a U.S. application filed June 14, 1999. Thus, Megerle et al. has an earliest effective filing date (i.e., Section 102(e) date) of June 14, 1999.

The attached Rule 131 Declaration provides evidence that prior to June 3, 1999 the inventors reduced to practice embodiments of the claimed invention, thereby antedating Zenhausern as a reference.

Accordingly, reconsideration and withdrawal of the anticipation rejection over Zenhausern are respectfully requested.

Claims 2-5, 7-10, 23 and 26 stand rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Zenhausern. This rejection has been obviated by the Rule 131 Declaration antedating Zenhausern as a reference. Accordingly, reconsideration and withdrawal of the obviousness rejection over Zenhausern are respectfully requested.

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Claims 18-20 stand rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Zenhausern in view of Mazumder et al. and Durland et al. This rejection has been obviated by the Rule 131 Declaration antedating Zenhausern as a reference. Accordingly, reconsideration and withdrawal of the obviousness rejection over Zenhausern in view of Mazumder et al. and Durland et al. are respectfully requested.


For at least the reasons set forth above, it is respectfully submitted that the above-identified application is in condition for allowance. Favorable reconsideration and prompt allowance of the claims are respectfully requested.

Should the Examiner believe that anything further is desirable in order to place the application in even better condition for allowance, the Examiner is invited to contact Applicants' undersigned attorney at the telephone number listed below.

Respectfully submitted,

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